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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,597	10/25/2001	Mark Krichever	646	6070

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EXAMINER
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LEE, DIANE I

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/040,597

Applicant(s)

KRICHEVER ET AL.

Examiner

Diane I. Lee

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*ML*

-- Th MAILING DATE of this communication appears on the cov r sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-20 are presented for examination.
2. Acknowledgment is made that this application is a continuation-in-part of Application Serial No. 09/227,245, filed 08 January 1999, which is a continuation-in-part of Application Serial No. 08/794,782 filed 13 February 1997, which issued as U.S. Patent No. 6,119,944.
3. Upon reviewing of the parent application Serial No. 08/794,782, the examiner has determined that the currently claimed invention has not been "wholly" disclosed until the current application. Specifically "the optical components supported by the housing which is movable between the first and the second positions to selectively optically modifying the light beam" is not found in the parent application (i.e., 08/794,785). Therefore, the effective filing date for the currently claimed invention is 8 January 1999.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner

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to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-12 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan et al. [US 6,098,877-referred as Barkan].

Re claims 1, 11, and 20: Barkan discloses a portable instrument such as a scanner for electro-optically reading coded indicia over an extended range of working distances, comprising:

a) a housing having a size and a shape configured to be held in a user's hand during reading (see figure 14b);

b) a plurality of electrical and optical components supported by the housing, for directing a light beam toward the indicia for reflection therefrom and for detecting light reflected from the indicia over a field of view, one of the components 172a, 172b being movable between first and second positions in which said one of the components is operative for optically modifying at least one of the light beam and the reflected light at first and second optical areas, respectively (see figure 15 and 16b); and

c) a manual actuator mounted on the housing for actuation by the user, and being operative for manually moving said one of the components between the first and second positions to selectively optically modify said at least one of the light beam and the reflected light at the first and second optical areas, respectively (see col. 14, lines 47+; col. 15, lines 8+; figure 14-16).

Although Barkan does not show the scanner having such configuration having all the element in one embodiment, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the optical elements shown in other embodiment as a possible implement components (e.g., dual mode optical) in the such configuration shown in figure 14b in order to extend the capability of the scanner and to provide an additional benefit such as a hand-held scanner with a dual mode configuration.

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Re claims 2: wherein another of the components is a light source for emitting the light beam, and wherein said one of the components includes a focusing lens for focusing the light beam at the first and second optical areas located in the range outside the housing, the first and second optical areas being foci located at different working distances relative to the housing (see col. 14, lines 66+ and figure 16b);

Re claims and 12: wherein reader further includes another of the components is a light detector 405 for detecting the reflected light and generating an electrical signal indicative thereof, a processor for processing the electrical signal into a processed signal during reading, component suitable to carry a batch data communication which obviously include a memory for storing the processed signal and for downloading the data, and wherein said one of the components includes a focusing lens 172a, 172b for focusing at the detector the reflected light from the indicia respectively located at the first and second optical areas in the range outside the housing, the first and second optical areas being located at different working distances relative to the housing (see col. 14, lines 66+ and figure 16b);

Re claim 4: wherein the light source 170 is a semiconductor laser (see col. 14, lines 66+);

Re claim 5: wherein the detector is a semiconductor photodiode (see col. 14, lines 8+);

Re claim 6: wherein the detector is a charge coupled device array (see col. 7, lines 34+);

Re claims 7-9: wherein the housing has a light-transmissive window 402 aimable at the indicia during reading, the housing is elongated and extends along an axis between opposite end regions, and wherein the window is located at one of the end regions, and wherein the window lies in a plane that is generally perpendicular to the axis (see figure 14b);

Re claim 10: Although Barkan does not show the window lies in a plane that is inclined to the axis; it would have been obvious matter of design variation to incline the angle of the window relative to a longitudinal axis of the reader to further facilitate the reading device. Since the applicant has not clearly stated that the window being inclined at an angle relative to an axis of the reader solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with

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perpendicular as well as inclined to a longitudinal axis of the reader. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japike*, 86 USPQ 70;

Re claims 18-19: although Barkan teaches the actuator is a trigger manually actuatable to initiate reading process (see col. 15, lines 8+ and figure 16b), he does not specifically states the actuator is a slide switch slidable along the housing.

Due to the fact that Barkan teaches many variations of the trigger designs such as different triggers, types, and mounting configuration in order to accommodate the user (see col. 18, lines 6+), implementing a slide switch that slidable along the housing would have been an obvious extension taught by Barkan.

7. Claims 13-14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan in view of Plesko [US 5,506,394]. The teachings of Barkan have been discussed above.

Barkan does not teach the reader having a pointing mode and storing an identifier such as an information unique to the user in the memory.

Plesko discloses a stylus bar code scanner (see figures 1-4) having a narrow, elongated housing 1 extending along an axis between opposite end regions, and having a size and shape configured to be held in a user's hand during scanning process which includes an aiming (pointing) mode and a reading mode, e.g., a detecting and a decoding process (see figures 1-3); a front end 16A of the scanner where the light enters and exits as indicated by 6, 7 in figure 7 serves as a light-transmissive window on the housing substantially perpendicular to the longitudinal axis of the reader and aimable at the target during the pointing mode for moving the light in a pattern over the target and creating a visual display on a target, and at the indicia during the reading mode (see col. 18, lines 1+); a plurality of electrical and optical components supported by the housing, for directing a light beam through the window (see figures 3-8); and a manual acutatable switch 2 mounted for movement by the user on the housing (see col. 15, lines

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61+ and figures 1-5). Plesko further teaches that the light source is a laser for generating the light beam as a visible beam (see col. 16, lines 46-48) and wherein the plurality of components includes a light sensor having a field of view and operative for detecting light reflected off the indicia through the window in the reading mode (see figures 7-8), and for generating an electrical signal indicative of the detected light (see col. 17, lines 9+); a processor 35 for processing the electrical signal into a processed signal during the reading mode (see figure 4a); and memory for storing the processed signal (see col. 17, lines 60+ and figure 7). Plesko discloses the memory of the device is used for retaining the scanned data and the device would be suited to variety system such as package delivering industries, inventory applications, portable hospital information reading application, and etc. (see col. 18, lines 1-8). The scanner is used in area such as a package delivery industry, inventory applications, portable hospital information reading application, and etc. would obviously require to read the data relating to user information such as includes an account number or billing number and a billing address for the user.

It would have been an obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporating the pointing mode capability in order to point/highlight a code/object in order to increase the identifying the object position, and incorporate the process of storing an identifier such as an information unique to the user in the memory implement the scanning operation in a specific transaction having a user account.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barkan in view of Huang [US 5,617,304]. Teachings of Barkan have been discussed above.

Barkan does not disclose the other end of the housing of portable instrument implementing a marker which facing a surface to be marked.

Huang discloses a portable, dual-use device for marking surface and an optical instrument. The dual-use device is supported by the housing (see figures 1-4) having a combination of laser pointer at one

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end and a marking implement such as a ballpoint pen unit at the opposite end regions of the housing capable of marking on paper (see figure 1). The housing bounds an interior in which the internal component 22 is accommodated. The housing as separable portions 10, 20, which upon separation, enable access to the interior and an exterior clip 25 for clipping the housing to a part of the user's clothing (see col. 1, line 59-col. 2, line 43 and figure 1).

In view of Huang's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to implement a notoriously well known dual-use instrument as taught by Huang in the teachings of Barkan by incorporating a conventional marking means and the housing structure of a dual-use instrument to the pen-shaped bar code reader of Barkan in order to provide the user with a pen shaped bar code reader that can also be held by a single hand of a user during both marking and data collection. Official Notice is taken that combining an optical instrument with a conventional marker so as to obtain an optical instrument and a marker in a compact and lightweight hand-held instrument that can also be held by a single hand of a user is old and well known in the optical art. See *In Re Malcolm* 1942 C.D.589:543 O.G. 440. Accordingly, such modification would have been an obvious extension taught by Barkan for a more versatile system and therefore, an obvious expedient.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



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10. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 6,119,944 in view of Barkan et al. [US 6,098,877]. The teachings of Barkan have been discussed above.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1-20 discloses a portable instrument such as a scanner for electro-optically reading coded indicia over an extended range of working distances having a housing having a size and a shape configured to be held in a user's hand during reading, a plurality of electrical and optical components supported by the housing, for directing a light beam toward the indicia for reflection therefrom and for detecting light reflected from the indicia over a field of view, one of the components being movable between first and second positions in which said one of the components is operative for optically modifying at least one of the light beam and the reflected light at first and second optical areas, respectively; and a manual actuator mounted on the housing for actuation by the user, and being operative for manually moving said one of the components between the first and second positions to selectively optically modify said at least one of the light beam and the reflected light at the first and second optical areas, respectively, and a marking implement supported by the housing for marking a surface. Where as in Patent 6,119,944 discloses a portable, dual-use instrument for marking surfaces, and for electro optically collecting data for subsequent downloading having a marking implement at one end regions of the housing and a data collector in other regions of the housing wherein the data collector includes a light source directing a light beam to the symbol a light sensor for detecting light reflected off the symbol and generating an electric signal indicative of the detected light, a processor for processing the electric signal, a memory for storing the processed signal for subsequent downloading, and a manual actuatable trigger for initiating scanning. Although, the scope of claims 1-20 of the present application and claims 1-34 of Patent 6,119,944 are identical, the difference between the inventions defined by the conflicting claims is the apparatus of the instant application includes utilization of additional electrical and optical component,

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such as utilizing movable optical elements operative for focusing the light beam having a first position during the first reading mode and a second position during reading mode.

Teachings of Barkan have been discussed above.

In view of Barkan's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ the movable optic lenses in the instant application in order to extend the range of working distance in which the bar code can be read.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Diane I. Lee  
Examiner  
Art Unit 2876

June 3, 2002